

REMARKS

Applicant appreciate the courtesies extended in the interview with the Examiner on December 21, 2006 and as discussed in the interview Applicant provides a response herein for consideration and summary of the issues discussed in the interview.

Reconsideration and allowance in view of the forgoing amendment and the following remarks are respectfully requested. Claims 3, 13, 15-18 and 28 are amended.

The title is amended as required in paragraph 2 of page 3 of the Office Action.

Rejection of Claims 3, 7-9, 13, 15, 16, 27 and 28 Under 35 U.S.C. § 103(a)

The Office Action rejects claims 3, 7-9, 15, 16, 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Chmaytelli (U.S. Patent No. 6,233,464) (“Chmaytelli”) in view of Sumner (U.S. Patent No. 6,091,947) (“Sumner”) in view of Watanabe et al. (U.S. Patent No. 5,675,641) (“Watanabe”) and further in view of Beghtol et al. (U.S. Patent No. 6,253,075) (“Beghtol et al.”). Applicant respectfully traverses this rejection and submits that one of skill in the art would not have sufficient motivation or suggestion to combine these references and even if combined these references fail to teach each limitation of the claims.

Applicant first comments on the Examiner’s response to arguments on page 2 of the outstanding Office Action. Applicant has discussed these limitations in the interview, but provides a summary of some of these discussed next. Applicant respectfully notes that the Office Action’s characterizations of the teachings of Chmaytelli on page 2 are inaccurate. For example, the Office Action states “the connection of the stylus is checked to determine whether to alert the user of the incoming phone call see column 1, lines 44-46.” Applicant respectfully notes that there is nothing in Chmaytelli that relates to how to manage an incoming phone call as is recited in the claims. Notably, column 1, lines 44-46, states that “the switch further allows selection as to whether either or both of these actions will also turn the telephone on or off. The switch further allows selection as to whether either or both of these actions will also open or

close the key path.” A summary of the teachings of Chmaytelli is that he discloses a system in which the stylus is associated with a switch such that the PDA and/or telephone feature may be turned on or off with the insertion or removal of the stylus. Applicant simply notes that the teachings of Chmaytelli related to what sequence of events occurs in response to the switch turning on and off as a stylus is inserted or removed are limited to whether the PDA or the telephone is simply turned on or off. Accordingly, the Office Action’s characterization of the stylus being used to alert the user of incoming phone calls goes beyond the scope of the teachings of Chmaytelli. Applicant, therefore, respectfully submits that the Office Action’s statement that “Applicant’s art is a slight modification in which the connection of the speaker/earplug/headset is checked to determine whether to alert the user of an incoming phone call” is a statement that is based on an incorrect characterization of the teachings of the prior art. Accordingly, Applicant respectfully submits that the modification in the claims regarding how to manage incoming phone calls is not therefore a slight modification of Chmaytelli.

The Office Action on page 2 also characterizes the teachings of Watanabe et al. incorrectly. Notably, the Office Action states “Watanabe et al. teaches determining whether a headset/earplug is connected or disconnected to a wireless device and manipulating the phone call based on the headset/earplug connection.” Applicant notes that Watanabe et al. teach an apparatus and method for operating a speaker telephone in full duplex mode or half duplex mode. As is shown in Figure 1 of Watanabe et al., they illustrate a desktop speaker phone having an earphone jack and also a telephone line jack 110. Figure 2 shows feature 110 again where the telephone line connects to the telephone and Figure 3 shows a telephone terminal 310 and the discussion throughout the specification in Watanabe et al. is limited to a land line desktop telephone. While Watanabe et al. could have suggested an aspect of their invention wherein it could apply in a wireless context; they simply failed to do so. Accordingly, Applicant

respectfully traverses the characterization in the Office Action that Watanabe et al. teach a wireless device when in fact it does not.

Furthermore, Applicant traverses the characterization in the Office Action of the teachings of Watanabe et al. related to the position of the headset/earplug being for “manipulating the phone call based on the headset/earplug connection.” Applicant also traverses the analysis and note that the controller in Watanabe et al. determines whether an earphone is connected or disconnected and if the earphone is disconnected, the controller places the speaker telephone in a half duplex mode of operation to prevent undesired feedback of speaker output to the microphones input. If the earphone is connected, the controller causes the speaker telephone to transition from the half duplex to the full duplex mode of operation. See column 1, lines 53-63. Applicant simply notes that the invention disclosed by Watanabe et al. is limited to the management of whether the telephone is in a half duplex mode or a full duplex mode. In the half duplex mode, telephone transmission via the microphone 130 and the telephone reception via the speaker are both possible. In the full duplex mode, the telephone transmission via the microphone 130 and reception via the speaker 120 are both possible but not simultaneously. If the earphone is removed from the jack, the speaker telephone automatically reverts to a half duplex mode. Accordingly, rather than manipulating the “phone call” based on the headset or earplug connection, Watanabe et al. teach the management of the microphone 130 and the speaker 120 in terms of being in either a half duplex mode or a full duplex mode. This does not suggest managing the phone call, but rather managing only the speaker phone. In other words, Applicant respectfully submits that the teachings of Watanabe et al. are much more distant from the claims in the present application than is represented in the outstanding Office Action.

Finally, Applicant notes that the last sentence of page 2 of the Office Action states “the headset condition would essentially be a step in between steps 206 and 208 of Figure 2 of Beghtol et al.” Applicant respectfully traverses this analysis and notes that if one were to insert

the presently claimed invention into the flowchart in Figure 2 of Beghtol et al. that the teachings of Beghtol et al. would be dramatically adjusted such that steps of 208, 210, 214, 216 and 218 of Figure 2 would be eliminated from Beghtol et al. Notably, this would happen because once an incoming call was received in step 206 if a new step was inserted which determined whether an earplug device was plugged into the mobile wireless device such that if the earplug was plugged in the device would receive the incoming phone call then the flow would proceed to step 212 which would be to handle the call normally. However, if the earplug device was not plugged into the mobile wireless device then the process would divert the incoming call to a voicemail application which in Beghtol et al.'s Figure 2 would proceed to step 220 which sends the call to voicemail. If one were to insert this step into the flowchart of Figure 2 then it becomes clear that there is no opportunity in the modified flow for steps 208, 210, 214, 216 or 218 to ever be operative and thus the core invention taught by Beghtol et al. would simply be eliminated. Referring to some of the obviousness sections of the MPEP quoted below, Applicant would respectfully submit that blending the teachings of these references would clear cause a dramatic revision of the teachings of Beghtol et al. which thus certainly weighs against the obviousness to combine these references.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must

present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

Furthermore, if the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. MPEP 2142.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991)

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). MPEP 2143.01.

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). MPEP 2143.01.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). MPEP 2142.02.

With these principles in mind, Applicant respectfully submits that one of skill in the art would not have sufficient motivation or suggestion to combine these references. As noted above, Watanabe et al. is limited in scope to a desktop land line speaker phone. As is shown in Figure 1, the reference teaches a large speaker phone and the telephone jack is shown as feature

110. Applicant submits that it would require in appropriate hindsight to include a suggestion or motivation that such an invention could be applicable or that the teachings of Watanabe et al. would be applicable or should be incorporated into a mobile wireless device, especially in terms of managing incoming phone calls and in the context of diverting incoming phone calls to a voicemail application. Another reason why one of skill in the art would not have insufficient motivation to use the teachings of Watanabe et al. both in the wireless context and in the context of managing incoming phone calls is that the speaker phone shown would clearly be used in the context of a live conversation. As noted above, the speaker phone being in either full duplex mode or half duplex mode is certainly a context when a user is actively speaking and listening to another person on the other end of the phone call. Accordingly, this context in the teachings of Watanabe et al. in addition to the lack of any reference to any wireless application would certainly not lead one of skill in the art to incorporate these teachings into a wireless mobile device and specifically also into a mobile device and how to divert incoming phone calls to a voicemail application. Certainly, if one is managing a live conference call then the thought process that is necessary to begin to determine how to manage voicemail application would not come to mind. Accordingly, Applicant respectfully submits that Watanabe et al. should not be combined with Chmaytelli or Beghtol et al.

Furthermore, Applicant respectfully submits that even if combined, these references fail to teach each claim limitation. For example, the feature of receiving an incoming phone call only when the earplug device is plugged into the mobile wireless device and diverting the incoming phone call to a voicemail application when the earplug device is not plugged into the mobile wireless device is not taught in the combination of the references. Notably, the switch in Chmaytelli is only limited to turning the telephone device on and off and the switch is a stylus and not an earplug device. Even if Chmaytelli is appropriately combined with Watanabe et al., which Applicant does not concede, that only provides the additional feature of a earplug device

which can change a speaker phone from a full duplex to a half duplex mode. Finally, Beghtol et al. focuses on a memory system in which a user can enter phone numbers to be rejected. Such that when an incoming call arrives the system checks whether the phone number of the incoming call is in the rejection memory and if so, then the system rejects the call and sends it to voicemail. If it is not in the rejection memory then the call can be handled normally. There is no teaching in the combination of these references in which a determination of whether an earplug device is plugged into a mobile device to receive an incoming phone call and diverting the incoming phone call to a voicemail application when the earplug device is not plugged in to the mobile wireless device. Accordingly, even if these references were combined they still lack this particular teaching and thus for this independent reason, Applicant respectfully submits that the claims are patentable. For the foregoing reasons, claims 3, 7, 8-9 and 12 are patentable.

For similar reasons, Applicant submits that claims 13, 15 and 16 are patentable, as well as computer readable medium claims 17, 18, 21-23 and 26. Claims 27 and 28 each depend from claim 3 and recite further limitations therefrom. Accordingly, these claims are patentable as well.

Applicant also notes that claims 3, 13 and 17 have been amended to clarify the claim language to reciting generally a mobile wireless device rather than previous language which included that reference to both a wireless handheld phone device and a person digital assistant. Furthermore, Applicant has amended the language regarding managing an incoming phone call to recite receiving an incoming phone call only when the earplug device is plugged into the mobile wireless device and diverting the incoming phone call to a voicemail application when the earplug device is not plugged into the mobile wireless device. Applicant respectfully submits that based on the arguments set forth above, that none of these claims amendments are necessary for patentability, but these claim amendments are made to both simplify the claim language as well as provide a more clear recitation of the invention. Dependent claim

amendments are made to render the claims consistent. These claim amendments are not made for patentability either. For example, the claim amendments to claims 15 and 16 are made simply for consistency with the amendments of claim 13. Accordingly, Applicant submits that none of these claim amendments are made for the purpose of patentability inasmuch as one of skill in the art would not have sufficient motivation or suggestion to combine these references and even if combined, the principles recited in managing incoming phone calls are not taught, even prior to the above amendments.

CONCLUSION

Having addressed all rejections and objections, Applicant respectfully submits that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Deposit Account No. 50-3102** for any deficiency or overpayment.

Respectfully submitted,

Date: January 4, 2007

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